

REMARKS:

Claims 35 and 47-55 remain withdrawn, claim 38 is amended, and claims 39-46 remain unchanged.

Claims 38-40, 42, and 44-46 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,979,941 (“Mosher”).

Independent claim 38 recites:

A method of making a badge comprising:
providing a card having a front surface, a back surface, and adhesive on the back surface;
adhering a backing to the back surface of the card;
cutting only the card into at least a first segment and a second segment and not the backing;
providing a card printer;
feeding the cut card and the backing into the card printer;
forming an image on the front surface of at least one of the first and second segments of the card after cutting the card;
removing the at least one of the first and second segments containing the image from the backing, the at least one of the first and second segments removed from the backing and containing the image having adhesive on the back surface thereof; and
coupling the at least one of the first and second segments containing the image to a finding with the adhesive on the back surface thereof.

To prove a *prima facie* case of anticipation, the Examiner must show that each and every element as set forth in the claim is either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

Mosher does not teach or suggest cutting only the card into at least a first segment and a second segment and not the backing. Rather, Mosher discloses cutting or scoring 24 being performed through both the face material and the release paper so that the user can separate the face material with the release paper and use the face material with the release paper attached thereto (see col. 4, lines 51-65). Accordingly, Mosher clearly does not teach cutting only the card and not the backing as claimed in independent claim 38.

Also, Mosher does not teach or suggest coupling the at least one of the first and second segments containing an image to a finding with adhesive on the at least one of the first and second segments containing the image. Rather, Mosher discloses adhering the card “directly to

the clothing of the individual" (see column 3, line 65 – column 4, line 4 and column 4, lines 52-57). Mosher does not have any disclosure relating to findings or attaching anything to findings.

In addition, Mosher does not teach or suggest, *inter alia*, providing a card printer and feeding a cut card and backing into the card printer. Mosher discloses "printing" and merely references "conventional printing means" (see col. 3, line 39). With this thin disclosure of printing, Mosher clearly does not disclose a card printer as claimed. The Examiner continues to inappropriately consider and interpret disclosure of the prior art references in an attempt to satisfy the claimed limitations "card" and "card printer". The Examiner continues to reject independent claim 38 in view of Mosher, which, as stated above, merely recites "conventional printing means", not a "card" and "card printer." The Examiner's only motivation for interpreting the "conventional printing means" of Mosher to be a card and card printer as claimed in independent claim 38 comes from Applicant's disclosure, and therefore, the Examiner's interpretation and rejections are improperly based upon hindsight.

Applicant has previously expressed the difference between conventional printers such as laser jet printers, dot-matrix printers, etc., and the card printer in the pending claims. Applicant has also previously expressed the well understood interpretations and meanings of the these words in the art of printing, and that those of ordinary skill in the art of printing understand that a particular meaning is applied to card printers and the manner in which they print and that card printers are not the same or interchangeable with conventional printers such as laser jet, dot-matrix, etc. The Examiner continues to ignore Applicant's remarks and these limitations of the claim. Accordingly, Applicant submits herewith, in Appendix A, a Declaration of James P. Peterson, a person that is clearly of ordinary skill in the art and the sole inventor of the subject matter of the present patent application, to corroborate what Applicant has been stating throughout prosecution of the present application.

As can be seen from the Declaration, the Examiner's interpretation of Mosher is inappropriate and the Examiner's lack of consideration given to claim terms such as "card" and "card printer" cannot continue.

For these and other reasons, Mosher does not teach or suggest the subject matter of independent claim 38. Accordingly, independent claim 38 is allowable. Claims 39-46 depend from independent claim 38 and are allowable for the same and other reasons as independent claim 38.

Claim 41 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Mosher in view of U.S. Patent No. 4,583,766 ("Wessel") and claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Mosher alone. Claims 41 and 43 depend from independent claim 38. Independent claim 38 is distinguished from the cited references for the reasons presented above, and dependent claims 41 and 43 are distinguished from the cited references for at least the same reasons as independent claim 38. Accordingly, these 35 U.S.C. §103(a) rejections of dependent claims 41 and 43 will not be addressed herein.

CONCLUSION:

In view of the foregoing, entry of the present amendment and allowance of the pending claims are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,



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APPENDIX A